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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,389	09/24/2001	Mark Ashby	034298-120	7856

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EXAMINER

TRINH, HOA B

ART UNIT

PAPER NUMBER

2814

DATE MAILED: 08/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,389

Applicant(s)

ASHBY ET AL.

Examiner

Vikki H Trinh

Art Unit

2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-10, 24 in Paper No. 7 is acknowledged.
2. Claims 11-23, 25-28 have been canceled.

Claim Rejections - 35 USC § 102

I. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

II. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Burney et al. (5800389).

In figures 1-10, Burney et al. (5800389) disclose a system having a catheter 15 including a closed distal end 30 and a side port 24 adjacent to the distal end, an adaptor or hub 40 having a tapered lumen with a large diameter proximal end and a small diameter distal end, wherein the adaptor is removable, as recited in claim 1. The examiner notes that the adaptor and the catheter/cannula are structurally equivalent to the claimed subject matter. In addition, they are two separate pieces, hence the adaptor is removable from the catheter/cannula. See also

columns 6 and 9. Furthermore, the examiner notes that the adaptor may be attached to the cannula by any conventional means, as recited in claim 2, so as to deliver a sponge material in a hydrated state.

Claim Rejections - 35 USC § 103

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

IV. Claims 3-6, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burney et al. '389, as applied to claim 1, in view of Burbank et al. (5775333).

Burney et al. '389 disclose the system substantially as claimed. However, Burney et al. '389 does not disclose a cannula having a side port, wherein the catheter is configured to fit within the cannula .

Nonetheless, Burbank et al. (5775333) teach a system comprising a catheter 11, 444 having a side port 13, 446 and a distal closed end 445, and a cannula 15, 468 having a side port 476. The cannula includes a first indexing member 790 and the catheter includes a second indexing member 766 so as to align the catheter and the cannula. The second indexing member has at least one projection and at least one corresponding recess. The cannula is a breast cannula. See figures 1A-17.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the system of Burney et al. '389 with the system, as taught by Burbank et al. '333 , so as to easily sample tissues.

V. Claims 7-9 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burney et al. '389, as applied to claim 1, in view of Burbank et al. (5775333) and further in view of Riley et al., "Percutaneous Liver Biopsy..." (Referred to hereinafter as Riley et al.).

The combination teaching of Burney et al. '389 in view of Burbank et al. (5775333) show a system for sampling tissues. However the combination teaching of Burney et al. '389 in view of Burbank et al. (5775333) fails to disclose a pledget of sponge material, wherein the sponge material is a radiopaque marker.

Nonetheless, Riley et al. teach a device for delivering a bioabsorbable Gelfoam or pledget, wherein the pledget is a radiopaque marker or media to a biopsy site.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined teaching of Burney et al. '389 in view of Burbank et al. (5775333) with a radiopaque marker made of a sponge material, as taught by Riley et al., so as to provide visualability and hemostasis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vikki H Trinh whose telephone number is 703-308-8238. The examiner can normally be reached on Mon.-Tues, Thurs.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 703-306-2794. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-308-7722 for After Final communications.

Art Unit: 2814

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Vikki Trinh
16 August 2002